

Docket No. 0018-1052-0 PCT

IN RE APPLICATION OF: HIDENORI OHKI ET AL

SERIAL NO: 09/308,237

FILED: MAY 21, 1999

FOR: CYCLOHEXAPEPTIDES HAVING ANTIMICROBIAL ACTIVITY



8p/1654

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RECEIVED

DEC 23 1999

SIR:

Transmitted herewith is an amendment in the above-identified application.

TECH CENTER 1600/

- ☒ No additional fee is required
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been established by a verified statement previously submitted.
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been established by a verified statement submitted herewith.
- ☐ Additional documents filed herewith:

The Fee has been calculated as shown below:

CLAIMS	CLAIMS REMAINING		HIGHEST NUMBER PREVIOUSLY PAID	NO. EXTRA CLAIMS	RATE	CALCULATIONS
TOTAL	15	MINUS	20	0	× \$18 =	\$0.00
INDEPENDENT	1	MINUS	3	0	× \$78 =	\$0.00
		<input type="checkbox"/> MULTIPLE DEPENDENT CLAIMS			+ \$260 =	\$0.00
		TOTAL OF ABOVE CALCULATIONS				\$0.00
		<input type="checkbox"/> Reduction by 50% for filing by Small Entity				\$0.00
		<input type="checkbox"/> Recordation of Assignment			+ \$40 =	\$0.00
		TOTAL				\$0.00

- ☐ A check in the amount of _____ is attached.
- ☒ Please charge any additional Fees for the papers being filed herewith and for which no check is enclosed herewith, or credit any overpayment to deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.
- ☒ If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time may be charged to Deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon
Registration No. 24,618

Daniel J. Pereira, Ph.D.
Registration No. P45,518

Fourth Floor
1755 Jefferson Davis Highway
Arlington, Virginia 22202
Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 11/98)

0018-1052-0 PCT



#5 1A
PLUAT
1/6/00

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :
HIDENORI OHKI ET AL : GROUP ART UNIT: 1654
SERIAL NO. 09/308,237 :
FILED: MAY 21, 1999 : EXAMINER: BORIN
FOR: ~~CYCLOHEXAPEPTIDES~~ :
HAVING ANTIMICROBIAL
ACTIVITY

RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Official Action dated December 9, 1999, Applicants elect, with traverse, Group I, Claims 1-9, 11, 13 for further prosecution on the merits. Furthermore, Applicants elect the species 4-[5-(4-pentyloxyphenyl)isoxazol-3-yl] where R1 is benzoyl and R2 is hydroxyl, for initial examination purposes only. Prior to examination on the merits, please amend the above-identified application as follows.

IN THE CLAIMS

Please amend the claims as follows:

Claims 2-9, line 1 of each, replace "A" with --The--.

Please add the following claims:

--15. The compound of Claim 1, wherein R1 is benzoyl and R2 is hydroxy.--

A1

15

Handwritten signature/initials in a box.

REMARKS

The Office has restricted this application under 35 U.S.C. §121 and §372 to the following Groups:

Group I: Claims 1-9, 11, and 13 drawn to cyclic polypeptides and their composition;

Group II: Claim 10, drawn to method of making peptides of Group I;

Group III: Claims 12 and 14, drawn to method of use of peptides of Group I.

Applicants have elected, with traverse, Group I, Claims 1-9, 11, and 13 and have elected the species 4-[5-(4-pentyloxyphenyl)isoxazol-3-yl] where R1 is benzoyl and R2 is hydroxyl for initial examination purposes only.

The Office argues that the inventions of Groups I-III do not relate to a single general inventive concept under PCT Rule Section 13.1, because under PCT Rule 13.2, they lack the same or corresponding special technical features. Specifically, the Office takes the position that Group I is the technical feature that links Groups I-III.

The Applicants disagree with the Examiner's position and submit that unity of invention does exist between Groups I-III because there is a technical relationship between the groups which involves the special technical feature. In particular, the special technical feature is in fact the cyclohexapeptides of the present invention. It is this special technical feature that defines the contribution which each of the Groups, taken as a whole, makes over the prior art.

Moreover, the MPEP §803 states as follows:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it

on the merits, even though it includes claims to distinct or independent inventions.

Applicants further traverse the restriction requirement on the grounds that a search of all claims would not impose a serious burden on the Office.

Applicants submit that the claims of the non-elected Groups II and III are drawn to processes of making and processes of using the compounds of Group I. Applicants respectfully request that upon finding the polypeptide claims of Group I allowable, the claims of Groups II and II be rejoined to the product claims (MPEP §821.04).

For the reasons set forth above, Applicants contend that the Restriction Requirement is improper and should be withdrawn. Applicants further submit that this application is now in a condition for examination on the merits. Early notice of such is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Daniel J. Pereira, Ph.D.
Registration No. P45,518

Crystal Square Five - Fourth Floor
1755 Jefferson Davis Highway
Arlington, VA 22202
(703) 413-3000
Fax #: (703)413-2220
DJPER/rac
I:\User\DJPER\00181052.rr